



JNG 98-001

2176
SC
#30
11-1803

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: *Gross et. al.*)
Serial No.: 09/014,414) Art Unit: 2176
Filed: 1/27/98) Examiner: Cesar B. Paula
For: *Word Checking Tool for Word Processing*)
Applications & Other Systems)-----)

Response to Restriction Requirement RECEIVED

Honorable Commissioner
of Patents and Trademarks
Washington, D.C. 20231

NOV 06 2003

Technology Center 2100

Dear Sir:

Applicants hereby submit the following response to the Office Action mailed October 3, 2003.

As an initial matter, Applicants traverse the restriction requirement, primarily on the basis that: (1) it is untimely – coming more than 5 years after the claims were submitted in substantially the same form as pending at this time; and (2) the Examiner cannot demonstrate that there is any reasonable additional burden at this point in examining both sets of claims.

MPEP 803 provides that:

“...if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”

The PTO has had the benefit of 5 years of examination of the present claims, during which time the PTO has ample opportunity to research and identify prior art that may be applicable to all the claims. The Applicants have submitted copious amounts of prior art. Thus, Applicants submit that the Office cannot possibly contend that there is any remaining “search” burden on the Examiner, particularly as the issues for the claims have now been narrowed down to a very small number.

Moreover, examination of the application, in whole, has already been done several times.

Consequently, Applicants submit that the present restriction requirement does not comply with the guidelines provided in the MPEP, and should be withdrawn.

Nonetheless, the Applicants would provisionally elect the claims identified in Group II of the restriction requirement to help expedite prosecution of the case.

Respectfully submitted,



October 31, 2003

J. Nicholas Gross, Attorney, Reg. No. 34,175

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I hereby certify that the foregoing is being deposited with the U.S. Postal Service, postage prepaid, to the Commissioner of Patents and Trademarks, this 31st day of October 2003.